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EXAMINER

BAHTA, KIDEST

ART UNIT

PAPER NUMBER

2123

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/624,872	Applicant(s) WHYTE, GARRY R.	
	Examiner KIDEST BAHTA	Art Unit 2123	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 5, 2008 has been entered.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-54, and 56-66 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The Federal Circuit has recently applied the practical application test in determining whether the claimed subject matter is statutory under 35 U.S.C. § 101. The practical application test requires that a "useful, concrete, and tangible result" be accomplished. An "abstract idea" when practically applied is eligible for a patent. As a consequence, an invention, which is eligible for patenting under 35 U.S.C. § 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The test for practical application is thus to determine whether the claimed invention produces a "useful, concrete and tangible result".

Art Unit: 2123

The current focus of the Patent Office in regard to statutory inventions under 35 U.S.C. § 101 for system and computer readable medium claims and claims that recite a judicial exception (software) is that the claimed invention recite a practical application. Practical application can be provided by a physical transformation or a useful, concrete and tangible result.

Claims 1, 9, 13, 14, 36, 46, 56, 57, 58, 59 recites an apparatus, a system, a computer-implemented method which does not produce a tangible result because the claimed subject matter fails to produce a result that is limited to have a real world value. the claimed subject matter is not clear what kind or who the code generator generate a code, using a machine or without using any machine. In addition, the claimed subject matter is claimed software. As stated in the Annex IV (pg. 52-54) of the above Guidelines, the claim is rejected for (i) not truly belonging to any of the four statutory categories; and (ii) for not able to realize its functionality in a whole in terms of tangible, concrete and useful result.

Dependent claims fail to remedy to the lack of hardware support hence are also rejected for not be categorized beyond an abstract level such as to yield statutory result required for a Practical Application.

Response for argument

3. Applicant's arguments filed 5/10/07 and 10/20/08 have been fully considered but they are not persuasive.

Applicant argues that Ambrogio fails to disclose visible information or Ambrogio's code is watermark which is invisible. However, the examiner disagrees since claims 1-37, 40-34, 45-47 and 49-59, do not disclose whether the code has to be visible or invisible. The claims simply claimed

a receiver operative to receive an object identifier;

Art Unit: 2123

***a code generator to generate a code;
a database operative to associate the code with the object identifier;
and a transmitter operative to transmit the code.***

In addition, the claims and only the claims form the metes and bounds of the invention. "Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541,550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, 1 45-48; p 2100-9, c 1, I 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. The Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

Applicant argues that Ambrogio provisional Patent Application does not disclose generate based 35 codes. However, examiner disagrees since in Ambrogio provisional Patent Application page 3, shows that the code is made from alphanumeric, which is based 35 code of alphanumeric.

Regarding claims 10, 32, 53, Applicant argues that Ambrogio does not disclose. Examiner disagrees since Ambrogio discloses [[0021], i.e., the readers 18A, 18B may be connected by any suitable communication means, such as for example the public telephone network, the Internet, or a wireless communication network, with the data center 12. The readers 18A, 18B (only two readers are shown in FIG. 1 for example purposes, though the system 10 may have any desirable number of readers) are capable of scanning the substantially invisible watermark 20' on the objects. The readers 18A-18B transmit the electronic data embodying the watermark to the data center 12, and the data center 12 identifies the identification code 24 included into the watermark. The data center 12 accesses the database 14 and compare the

Art Unit: 2123

identified identification code of the read watermark with the stored identification codes in the registers 26 of the database. *If a matching identification code is found in the database, then the data center 12 sends another response to the reader 18A, 18B instructing the reader to display an "invalid" readout on the reader display. The "valid" readout by the reader 18A, 18B indicates that the object B1'-Bi' is authentic or that the association of the object to entity A is authentic. The "invalid" readout shows that the object is not authentic.*

For the above reason, the rejection of claims 1-59 are pending in the application. Claims 1-37, 40-43, 45-47, and 49-59 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0179902 to Ambrogio et al. Claims 44 and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ambrogio in view of U.S. Patent Application Publication No. 2003/0217267 to Kindberg. Claims 38 and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ambrogio in view of U.S. Patent Application Publication No. 2002/0178959 to Rennard are maintained.

However, for newly add claim 60-66 are rejected Ambrogio in view of Fotland.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international

Art Unit: 2123

application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-37, 40-43, 45-47 and 49-59 rejected under 35 U.S.C. 102(e) as being anticipated by Ambrogio et al. (US 2003/0179902).

Regarding claims 1-37, 40-43, 45-47 and 49-59 Ambrogio discloses,

1. An apparatus, comprising: a receiver operative to receive an object identifier [0019]; a code generator to generate a code ([0013], [0018]); a database operative to associate the code with the object identifier ([0017], [0022]); and a transmitter operative to transmit the code [Fig. 1; [0013]].
2. An apparatus according to claim 1, wherein the receiver is operative to receive information about the object (element 16); and the database is operative to associate the information with the object identifier ([0013], [0017]).
3. An apparatus according to claim 1, wherein the code generator includes a random number generator [0016].
4. An apparatus according to claim 1, wherein the code generator is operative to generate base-35 codes ([0016]-[0017], i.e., an alphanumeric code).
5. An apparatus according to claim 1, wherein the code generator is operative to generate alphanumeric codes [0017].

6. An apparatus according to claim 1, further comprising a verifier operative to verify that a request to generate the code comes from a manufacturer of an object identified by the object identifier [0014].
7. An apparatus according to claim 1, further comprising a code comparator to compare the code with a second code in the database [0021].
8. An apparatus according to claim 1, further comprising a computer including the receiver (Fig. 1), the code generator (Abstract), the database (12), and the transmitter (Fig. 1, element A & B).
9. An apparatus, comprising: a database including at least a first code associated with a first object identifier and a first information about an object identified by the object identifier (Fig. 1; Abstract, [0013]); a receiver operative to receive an inquiry about a second code (Fig. 1); a code comparator to compare the second code with the first code ([0021]; and a transmitter operative to transmit the first information associated with the first object identifier if the second code matches the first code [0012].
10. An apparatus according to claim 9, wherein: the apparatus further comprises a notice indicating that the second code is not valid [0021]; and the transmitter is operative to transmit the notice if the second code does not match the first code

Art Unit: 2123

[0021].

11. An apparatus according to claim 9, wherein the database is operative to associate the inquiry with the first object identifier if the second code matches the first code [0022].

12. An apparatus according to claim 9, wherein: the receiver is operative to receive additional information [0022]; and the database is operative to associate the additional information with the first object identifier if the second code matches the first code [0022].

13. A system, comprising: a receiver operative to receive from a requester (Fig. 1): a request for a code for an object identified by an object identifier and an information about the object (abstract); a code generator to generate the code [0018]; a database operative to associate the code with the object identifier and to associate the information with the object identifier [0017]; a verifier operative to verify that the requester is a manufacturer of the object [0014]; a code comparator to compare the code with a second code in the database; a transmitter operative to transmit the code to the requester [0021]; means for placing the code on the an object identified by the object identifier [0018]; means for searching the database for the code responsive to an inquiry about the code from an inquirer, the inquiry received by the receiver ([0020]-[0022]; and means for retrieving the information associated with the object identifier from the

Art Unit: 2123

database, the information transmitted by the transmitter to the inquirer (Fig. 1).

14. A computer-implemented method for using a code, comprising: receiving a request for a code (00, the request including an object identifier [0013]; generating the code [0008]; adding the object identifier to a database [0013]; associating the code with the object identifier in the database [0013]; and responding to the request with the code [0013].

15. A method according to claim 14, wherein generating the code includes determining whether the code is already associated with a second object identifier in the database ([0021]-0022)).

16. A method according to claim 15, wherein generating the code further includes generating a second code if the code is already associated with the second object identifier in the database [0020].

17. A method according to claim 14, wherein generating the code includes randomly generating the code [0016].

18. A method according to claim 17, wherein generating the code includes using a random number generator to randomly generate the code [0016].

19. A method according to claim 14, wherein generating the code includes

generating an alphanumeric code [0016].

20. A method according to claim 14, wherein generating the code includes generating an base-35 code ([0016]-[0017], i.e., an alphanumeric code).

21. A method according to claim 14, wherein: receiving a request includes receiving a manufacturer identifier [0020]; and associating the code with the object identifier includes associating the manufacturer identifier with the object identifier [0020].

22. A method according to claim 14, further comprising verifying that a manufacturer of an object identified by the object identifier made the request [0021].

23. A method according to claim 22, wherein verifying that a manufacturer of an object identified by the object identifier made the request includes requesting the manufacturer to verify that it made the request ([0020]-[0022]).

24. A method according to claim 22, wherein receiving a request includes receiving a manufacturer code associated with the manufacturer (Fig. 1); and verifying that a manufacturer of an object identified by the object identifier made the request includes searching the database to determine if the manufacturer code is associated with an identifier of the manufacturer ([0021]-[0022]).

25. A method according to claim 24, wherein verifying that a manufacturer of an object identified by the object identifier made the request further includes, if the manufacturer code is not associated with the identifier of the manufacturer, sending a message to the manufacturer [0022].

26. A method according to claim 14, wherein receiving a request includes receiving information (0018]; and the method further includes associating the information with the object identifier (0017].

27. A method according to claim 26, wherein receiving information includes receiving a question 0021]- [0022]); and associating the information includes associating the question with the object identifier [0021].

28. A computer-implemented method for using a code, comprising: receiving an inquiry from a requester, the inquiry including the code [0021]; searching a database to determine if the code is associated with an object identifier in the database [0021]; and if the code is associated with an object identifier: accessing information associated with the object identifier[0021]; and returning the information to the requester ([0021]-[0022]).

29. A method according to claim 28, further comprising receiving update information from the requester [0022].

30. A method according to claim 29, further comprising associating the update information with the object identifier in the database [0022].

31. A method according to claim 29, further comprising sending the update information to a manufacturer identified by a manufacturer identifier associated with the object identifier [0022].

32. A method according to claim 28, further comprising, if the code is not associated with an object identifier, returning to the requester a notice that the code is not valid [0021]-0022)).

33. A method according to claim 32, further comprising: requesting additional information from the requester [0022]; and receiving the additional information from the requester [0022].

34. A method according to claim 33, further comprising sending the additional information to a manufacturer identified by a manufacturer identifier associated with the object identifier [0013].

35. A method according to claim 28, further comprising associating the request with the object identifier (Abstract).

Art Unit: 2123

36. A computer-implemented method for using a code, comprising: identifying an object ([0017]–[0019]); requesting a code for the object from a computer ([0017]–[0019]); the request including an object identifier for the object ([0017]–[0019]); receiving the code for the object ([0017]–[0019]); and placing the code on the object [0019].

37. A method according to claim 36, wherein placing the code on the object includes printing the code on the object [0019].

40. A method according to claim 36, wherein placing the code on the object includes printing the code on a material separate from but included with the object [0019].

41. A method according to claim 36, wherein requesting a code includes providing information about the object to the computer ([0019]–[0022]).

42. A method according to claim 41, wherein providing information includes providing an identifier for a manufacturer of the object [0020].

43. A method according to claim 41, wherein providing information includes providing a second code associated with a second object [0020].

45. A method according to claim 36, wherein receiving the code includes

Art Unit: 2123

receiving an alphanumeric code; and the method further comprises converting the alphanumeric code to a machine-readable code ([006]).

46. A computer-implemented method for using a code, comprising: determining a code from an object (Abstract); providing the code to a computer (Fig. 1); and receiving information from the computer concerning an object identified by an object identifier associated with the code [0016]-[0021].

47. A method according to claim 46, wherein receiving information includes receiving a question from the computer [0019]; and the method further comprises: preparing a response to the question and providing the response to the computer ([0019]-0021)).

49. A method according to claim 46, further comprising providing additional information to the computer [0 022].

50. A method according to claim 46, wherein providing the code includes scanning the code using a machine [0024].

51. A method according to claim 46, wherein determining a code includes reading the code from the object [0021].

52. A method according to claim 46, wherein determining a code includes

Art Unit: 2123

determining the code from a material separate from but included with the object [0019].

53. A method according to claim 46, wherein receiving information from the computer includes receiving a notice from the computer that the code is not valid [0021]:

54. A method according to claim 53, further comprising: receiving a request for information about the code from the computer ([0018], 0021)); and providing the information about the code to the computer [0021].

55. A computer-implemented method for using a code, comprising: identifying an object by a manufacturer [0020]; requesting a code for the object from a computer by the manufacturer, the request including an object identifier for the object and an information about the object [0013]; receiving the code for the object by the manufacturer [0020]; and placing the code on the object by the manufacturer [0019]; delivering the object by the manufacturer to an inquirer [0020]; determining the code from the object by the inquirer [0021]; providing the code to the computer by the inquirer [0021]; and receiving the information about the object from the computer by the inquirer [0022].

56. Computer-readable medium containing a program to use a code, comprising: software to receive a request for a code, the request including an object identifier

Art Unit: 2123

[Abstract]; software to generate the code [0016]; software to add the object identifier to a database [0016]; software to associate the code with the object identifier in the database [0016]; and software to respond to the request with the code [0016].

57. Computer-readable medium containing a program to use a code, comprising: software to receive an inquiry from a requester [0013], the inquiry including the code [0013]; software to search a database to determine if the code is associated with an object identifier in the database [0013]; and if the code is associated with an object identifier [0013]: software to access information associated with the object identifier [0013]; and software to return the information to the requester [0013].

58. Computer-readable medium containing a program to use a code, comprising: software to identify an object [0016]; software to request a code for the object from a computer, the request including an object identifier for the object [0019]; software to receive the code for the object [0019]; and software to place the code on the object [0019].

59. Computer-readable medium containing a program to use a code, comprising: software to determine a code from an object [0021]; software to provide the code to a computer [0021]; and software to receive information from the computer

Art Unit: 2123

concerning an object identified by an object identifier associated with the code [0022].

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 44, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over in Ambrogio et al. (US 2003/0135432) view of Kindberg (US 2003/02172667).

Regarding claims 44 and 48, Ambrogio discloses the limitation of claims 36, 41 and 46 but fails to disclose the limitation of claims 44 and 48. However, Kindberg discloses receiving information includes receiving a hyperlink that can be used to access additional information about the object; and the method further comprises using the hyperlink to access the additional information (Abstract, Fig. 1, Fig. 2A).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify the teachings of Ambrogio with the teachings of Kindberg in order to provide a means and methodology for authentication for hyperlinks from physical object, or entities, to Internet resources.

8. Claims 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over in Ambrogio et al. (US 2003/0135432) view of Rennard (US 2002/0178959).

Regarding claims 38-39, Ambrogio discloses the limitation of claim 36 but fails to disclose the limitation of claims 38-39. However, Rennard discloses placing the code on the object includes etching the code on the object and etching the code includes etching the code on the object using a laser [0018].

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify the teachings of Ambrogio with the teachings of Rennard since such system would thus allow casings found at crime scenes to be traced to the person who purchased them greatly enhancing the ability of law enforcement agencies to quickly and confidently solve crimes.

9. Claims 60-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over in Ambrogio et al. (US 2003/0135432) view of Fotland (US 3,961,574).

Regarding claims 60-66, Ambrogio discloses the limitation of claims 1, 9, 13, 14, 36, 46, and 55 but fails to disclose the limitation of claims 60-66. However, Fotland discloses the code is designed to be visible to a user of an object onto which the code is affixed, so that the user can read the code from the object with his eyes (Abstract, i.e., A printing apparatus for generating visible bar code code images in accordance with an electronic input command which comprises: a conducting mask containing a slot, a fine diameter ion emitting

Art Unit: 2123

wire positioned on one side of the mask and adjacent to this slot and an electrically conductive support member).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify the teachings of Ambrogio with the teachings of Fotland since such system and method is make it easy to see and read the bar code.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed Kidest Bahta whose telephone number is 571-272-3737. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Rodriguez can be reached on 571-272-3753. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application information Retrieval IPAIRI system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAG system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 2123

/Kideest Bahta/

Primary Examiner, Art Unit 2125